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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,017	08/02/2000	Jerry Wynn Brimer	NORTH-358G/A-2185 D1	1088

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STETINA BRUNDA GARRED & BRUCKER  
75 ENTERPRISE, SUITE 250  
ALISO VIEJO, CA 92656

EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
1773	22

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/632,017	<b>Applicant(s)</b> BRIMER ET AL.
	<b>Examiner</b> Monique R Jackson	<b>Art Unit</b> 1773
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b>		
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
<p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>28 October 2002</u>.</p> <p>2a)<input checked="" type="checkbox"/> This action is <b>FINAL</b>.      2b)<input type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>		
<b>Disposition of Claims</b>		
<p>4)<input checked="" type="checkbox"/> Claim(s) <u>16-36</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>16-36</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>		
<b>Application Papers</b>		
<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="text-align: center;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11)<input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved by the Examiner.</p> <p style="text-align: center;">If approved, corrected drawings are required in reply to this Office action.</p> <p>12)<input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>		
<p>13)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p>1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p>3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>* See the attached detailed Office action for a list of the certified copies not received.</p>		
<p>14)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).</p> <p>a)<input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15)<input checked="" type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>		
<b>Attachment(s)</b>		
<p>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.</p> <p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____</p>		

### **DETAILED ACTION**

1. The amendment filed 10/28/02 has been entered. New claims 26-36 have been added. Claims 16-36 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 112*

3. Claims 16-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons recited in the prior office action with regards to the term "high curing temperature powder adhesive". Additionally it is noted that the instant disclosure at the time of filing does not provide support for the limitation "lower than a maximum acid-impervious temperature level of the particulate" as recited in Claims 16, 20 and 26. The instant disclosure at the time of filing recites, "Preferably, the polymer particulate is temperature resistant [acid impervious] up to about 700°F, while the powder adhesive in all cases of course cures below the temperature-resistant [acid impervious] level of the polymer particulate" in Page 3, lines 14-17. This recitation does not suggest a disclosure of the "maximum acid-impervious temperature level of the particulate" or that the powder adhesive can be cured to a temperature up to the maximum acid-impervious temperature level particularly given that the disclosure further recites that the adhesive cures at a temperature of less than 650°F while the particulate is acid impervious up to 700°F thereby including a range of 650-700°F that was not previously presented.

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4. Claims 29-30 and 33-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 29 and 33 recite the limitation, "to mitigate the acid of the steel from penetrating therethrough." However, as discussed in great detail in the prior office action, the instant disclosure at the time of filing does not provide support for acid contained in the steel.

5. Claims 16-25 and 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons recited in the prior office action with regards to the relative term "high curing temperature".

6. Claims 16-25 and 31-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 16 and 20 recite the limitation "for forming an acid-containing part...to mitigate the acid of the part from penetrating therethrough". However, the term "for forming an acid-containing part" in the preamble is a recitation of future use of the metal structure or curing fixture and hence there is no "acid" present in the invention. Similarly, Claim 31 recites the limitation "greater than a leaching temperature of the part" however there is no part given that the term "for forming an acid-containing part" in the preamble is a recitation of future use. Therefore it is unclear whether the Applicant's intention is to claim the metal structure/fixture or the acid-containing part comprising the metal structure/fixture.

***Claim Rejections - 35 USC § 102***

7. Claims 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Millar et al (USPN 4,027,366.) As discussed in Paper No. 14, Millar et al teach a process for electrostatically applying a particulate coating composition to a substrate such as a steel substrate (*hence a metal structure/curing fixture comprising a steel surface having deposited thereon a mixture*), wherein the particulate coating composition comprises a mixture of powders of at least two different coating materials selected from conducting metal or non-metal powders such as zinc, steel or graphite; non-conducting thermoplastic powders such as polyolefins, nylons and other polyamides (*acid-impervious polymer particulate up to about 700°F*); and/or thermosetting polymers like epoxies, acrylics and crosslinkable vinyl polymers; wherein at least one of the powders will be a powder of a film-forming non-conductive organic or inorganic polymer (*powder adhesive*) and wherein the powders may be blended together and then electrostatically deposited in a single operation or step to the substrate to adhere the powder mixture to the surface via contact or static electrification for a reasonable length of time and until at least one of the powders can be cured or fused at a curing temperature from about 140°F to 1500°F, preferably 200°F to 700°F, (*encompassing the instantly claimed temperature ranges*) to form the final coating (*film*) which is at least two distinct layers of different composition wherein one layer may have more than one component (Abstract; Col. 2, lines 39-57; Col. 3, lines 45-63; Col. 4, lines 9-14 and 27-28; Col. 5, lines 1-17 and 35-54; Col. 6, lines 25-37, 45-52, and 61-64; Col. 7, lines 19-40 and 52-65.)

*Response to Arguments*

8. Applicant's arguments filed 10/28/02 have been fully considered but they are not persuasive. The Applicant argues that the proposed amendments do not contain new matter and refers the Examiner to particular portions of the original disclosure that support the claimed invention. However, the Examiner refers the Applicant to the above reasons for the new matter rejections, noting that the original disclosure at the time of filing does not describe explicitly or inherently the claimed limitations. As for the Applicant's arguments with regards to the term "high curing temperature", this term is also discussed in great detail in the prior office action and as stated previously, the sections noted by the Applicant actually support the Examiner's position that the original disclosure only provides an upper limit and not a lower limit and hence would not reasonably convey an invention with "high curing temperature" powder adhesive given that room temperature falls within the temperature limit of the original disclosure and is not typically considered a "high" temperature. Though the Applicant has referred the Examiner to a recitation in the background section regarding high-temperature polymer composite materials that cure above about 500°F that will corrode the steel fixture, this recitation refers to the composite material and not the powder adhesive in the coating on the steel fixture, and hence this recitation does not provide a support for the term "high curing temperature powder adhesive" or a definition for the term "high curing temperature".

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*mrj*

January 7, 2003

*Paul Thibodeau*  
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